

1-1-2010

Free Speech or Trademark Protections: Do Advocacy Groups and Government Agencies Deserve Extra Protection

Max Landaw

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Recommended Citation

Max Landaw, *Free Speech or Trademark Protections: Do Advocacy Groups and Government Agencies Deserve Extra Protection*, 33 HASTINGS COMM. & ENT. L.J. 113 (2010).
Available at: https://repository.uchastings.edu/hastings_comm_ent_law_journal/vol33/iss1/5

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Free Speech or Trademark Protections: Do Advocacy Groups and Government Agencies Deserve Extra Protection?

by
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I. Introduction

“This is a fraudulent press activity and a stunt,” said Eric Wohlschlegel of the United States Chamber of Commerce on October 19, 2009.¹ This “stunt” was pulled off by the Yes Men, a parody group that describes itself as a “genderless, loose-knit association of some 300 impostors worldwide who agree their way into the fortified compounds of commerce”—and then unleash the clowns of public relations war.”² Thus, the Chamber filed a lawsuit against the Yes Men, claiming, amongst other things, trademark infringement under the Lanham Act.³

This lawsuit is typical of the type of litigation stemming from the Lanham Act. The court hearing the claims of the Chamber will

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1. Matthew Lasar, *EFF Defends Yes Men From Business Rage Over Climate Hoax*, ARS TECHNICA (Oct. 23, 2009, 11:30 AM), <http://arstechnica.com/web/news/2009/10/eff-tells-business-group-to-get-over-yes-men-hoax.ars>.

2. *Id.*

3. Complaint and Demand for Jury Trial, Chamber of Commerce of the US v. Servin, 1:09-cv-02014-RWR (filed Oct. 26, 2009).

mediate the balancing act between trademark and First Amendment protection. However, the case law virtually ignores the novelty of having an advocacy group as the plaintiff. Although many elements must be satisfied to prove a trademark infringement, the elements of confusion and commercial intent are considerably easier to show when an advocacy group operates significantly in the business and political realms.⁴

Just as government entities deserve special latitude in trademark infringement claims, so do advocacy groups and, by extension, governmental agencies. The public interest in preventing disastrous consumer confusion outweighs the First Amendment interests of parody groups. This paper will be divided into three parts. The first two sections will cover consumer confusion and commercial intent, the two main elements of a Lanham Act trademark infringement claim.⁵ The third section will reconcile the two competing public policy concerns of trademark and First Amendment protection.

II. Background

At the heart of this conflict between the Chamber and the Yes Men are the provisions of the Lanham Act, which was passed by Congress in 1946.⁶ The Commerce Clause of the Constitution grants Congress the authority to enact such legislation.⁷ The idea behind the legislation “was to grant more rights to the trademark owners by giving them a cause of action to protect their investments in the advertising process.”⁸ Proponents of the legislation argued that it would benefit the consumers, “who were unable to police trademark infringements on their own.”⁹

The Trademark Protection Act of 1881 and a modified statute in 1905 preceded the current trademark legislation enacted by Congress.¹⁰ The 1905 modification increased protections for trademark holders (and consumers, arguably) by lowering the standard for proving a violation of the federal Act.¹¹ Congress passed

4. 15 U.S.C. § 1114 (1946).

5. *Id.*

6. Samuel Feng, *Trademark: Its History, Influence, and Issues*, CONNEXIONS (Sept. 15 2005, 2:20 PM), <http://cnx.org/content/m13021/latest/>.

7. *Id.*

8. *Id.*

9. *Id.*

10. *Id.*

11. *Id.*

the Lanham Act in the wake of a huge consumer boom after World War II in 1946.¹²

The lawsuit at hand deals with a trademark infringement claim where the U.S. Chamber of Commerce claims that the Yes Men infringed on the Chamber's trademark.¹³ In response to the U.S. Chamber of Commerce's recent criticism of climate change legislation, the Yes Men created a website announcing a phony press conference where they would discuss issues such as the Chamber's "new" stance on environmental policy.¹⁴ At this press conference, a Yes Men member calling himself Hingo Sembrá, deputy to U.S. Chamber of Commerce President and CEO Tom Donahue, stated that the Chamber had reversed its policy on climate change legislation.¹⁵ This caused considerable confusion, as for a short time, news outlets such as Reuters and Fox News were reporting from the phony website and press conference that the Chamber had reversed its position.¹⁶ Apparently, the parody had worked a little too well. A week later, the Chamber sued the Yes Men for trademark infringement, stating that the parody had caused consumer confusion.¹⁷

The Yes Men prank was well-timed, coming shortly after the Chamber's announcement that it was against environmental legislation as being bad for business. This statement had caused the likes of Pacific, Gas & Electric ("PG&E") and certain gas companies such as Exelon¹⁸ to leave the Chamber, which claims to represent over three million businesses.¹⁹ Since its formation in 1912, the Chamber's purpose has been to advocate for the interests of big

12. *Id.*

13. Complaint and Demand for Jury Trial at 1, Chamber of Commerce of the U.S. v. Servin, 1:09-cv-02014-RWR (filed Oct. 26, 2009).

14. Wendy Davis, *US Chamber of Commerce Sues Yes Men For Creating 'Fraudulent' Site*, MEDIAPOST (Oct. 27, 2009, 8:45 PM), http://www.mediapost.com/publications/?fa=Articles.showArticle&art_id=116230.

15. *Id.*

16. Dana Milbank, *The News is Broken*, WASH. POST (Oct. 20, 2009), <http://www.washingtonpost.com/wp-yn/content/article/2009/10/19/AR2009101902988.html>.

17. Lasar, *supra* note 1.

18. *Apple, Citing Climate, tells US Chamber iQuit*, REUTERS (Oct. 5, 2009), available at <http://www.reuters.com/article/idUSN0519277320091005>.

19. *About U.S. Chamber Small Business Nation*, U.S. CHAMBER OF COMMERCE SMALL BUSINESS NATION, <http://www.uschambersmallbusinessnation.com/about-us/> (last visited Aug. 25, 2010).

business.²⁰ Its board of directors consists of more than a hundred senior executives at major companies such as Dow Chemical, Charles Schwab, and AT&T.²¹ Although the Chamber is known for its support of and membership from large businesses, the Chamber claims that ninety-six percent of its members are small businesses.²² In 2009 alone, the Chamber spent \$65.2 million in lobbying.²³

Thus, the Yes Men decided to tackle one of the largest advocacy groups in the nation. This is not new for them. The group is known for forming mock websites and posing as phony spokespersons for the purpose of parodying large corporations or governmental entities. For example, the group's most notorious stunt to date was against the World Trade Organization ("WTO").²⁴ The Yes Men created a phony website for the group and spoke for the WTO, encouraging corporations to purchase votes from its citizens and arguing that the U.S. Civil War was a waste of money because slaves were easy to secure from the third world.²⁵ To add to the ridiculousness of the claims, they then unveiled a gold spandex body suit which had the ability to oversee workers.²⁶ The Chamber, interestingly enough, has been the first entity to sue the Yes Men.

The complaint against the Yes Men, which the Chamber filed on October 26, 2009, contains eight causes of action: trademark infringement under the Lanham Act,²⁷ unfair competition under the Lanham Act,²⁸ trademark dilution under the Lanham Act, false advertising under the Lanham Act,²⁹ cyberpiracy under the Anti-Cyber Squatting Consumer Protection Act, unlawful trade practices,

20. *U.S. Chamber of Commerce, MEDIA MATTERS ACTION NETWORK* http://mediamattersaction.org/transparency/organization/US_Chamber_of_Commerce (last visited Aug. 25, 2010).

21. *Board of Directors, U.S. CHAMBER OF COMMERCE*, <http://www.uschamber.com/about/board/board-directors> (last visited Aug. 25, 2010).

22. *About U.S. Chamber Small Business Nation, U.S. CHAMBER OF COMMERCE SMALL BUSINESS NATION*, <http://www.uschambersmallbusinessnation.com/about-us/> (last visited Aug. 25, 2010).

23. David J. Lynch, "Change" puts U.S. Chamber of Commerce on the Spot, *USA TODAY* (Nov. 12, 2009, 1:53 AM), http://www.usatoday.com/money/companies/2009-11-11-Chamber11_cv_N.htm.

24. Roger Ebert, *The Yes Men*, *ROGEREBERT.COM* (Oct. 1, 2004), <http://rogerebert.suntimes.com/apps/pbcs.dll/article?AID=/20041001/REVIEWS/40920009/1023>.

25. *Id.*

26. *Id.*

27. 15 U.S.C. § 1114 (1946).

28. 15 U.S.C. § 45 (1946).

29. 15 U.S.C. § 1125 (1946).

publication of injurious falsehood, and a prima facie tort.³⁰ The complaint's prayer for relief includes injunctive and declaratory relief.³¹ In addition, the complaint claims that the prank against the Chamber was a publicity stunt the Yes Men used to promote their upcoming film, *The Yes Men Fix the World*.³² The film was released on October 23, 2009, just days after the incident.³³ It "is a screwball true story that follows a couple of gonzo political activists as they infiltrate the world of big business and pull off outrageous pranks that point out how corporate greed is destroying the planet."³⁴ Thus, the Chamber claims that a prank such as the one pulled against the Chamber would essentially be a preview for the upcoming film.

III. Consumer Confusion

At the crux of the issue of whether confusion should play a role in the debate between trademark and the right of free speech is the American experience with social critique. Professor Sonia Katyal identifies the concept of a dynamic "semiotic democracy" (coined by media studies professor John Fiske) as the "type of world where audiences freely and widely engage in the use of cultural symbols in response to the forces of media."³⁵ Katyal points out that a semiotic democracy is symptomatic of a functioning political democracy where "'political democracy' describes a system in which individual citizens are able to participate in the exercise of political power, [and] 'semiotic democracy' describes a system in which individual citizens are able to participate in the creation of cultural meaning."³⁶ Katyal goes on to argue that principles of trademark and copyright ownership have jeopardized the semiotic democracy, sanctifying the symbols and images of corporations. In turn, this has led artists to abandon projects for fear of suit.³⁷

Another reaction to the consecration of trademark and copyright principles in this area is the formation of what Katyal calls "semiotic

30. Complaint and Demand for Jury Trial at 2–3, Chamber of Commerce of the US v. Servin, 1:09-cv-02014-RWR (filed Oct. 26, 2009).

31. *Id.* at 3.

32. *THE YES MEN FIX THE WORLD* (Shadow Distribution 2009).

33. Complaint and Demand for Jury Trial at 6, Chamber of Commerce of the US v. Servin, 1:09-cv-02014-RWR (filed Oct. 26, 2009).

34. *The Yes Men Fix the World*, THE INTERNET MOVIE DATABASE, <http://www.imdb.com/video/wab/vi1429472025/> (last visited Aug. 25 2010).

35. Sonya Katyal, *Semiotic Disobedience*, 84 WASH. U. L. REV. 489 (2006).

36. *Id.* at 491.

37. *Id.* at 492.

disobedience,” a concept similar to civil disobedience where artists will deliberately put themselves at risk of violating the law that governs intellectual and tangible property.³⁸ This concept serves as a sort of rebellion with a purpose nobler than simply pulling pranks. Rather, it is a plea for the freedom to create and for a renaissance in the marketplace of ideas.

Katyal then presents a few examples of recent semiotic disobedience. In 1999, Nike implemented a promotional program that allowed consumers to personalize their shoes with a word of their choice next to the Nike logo.³⁹ One person, Jonah Peretti, elected to have the word “sweatshop” stitched onto his personalized shoes.⁴⁰ However, Nike reserved the right to reject a petition for a stitched word if such a word fell within a predetermined category such as “profanity or inappropriate slang.”⁴¹ Although Peretti was never granted an enshrined jab at Nike on his shoes, his actions serve as one demonstration of rebellious behavior against a corporation. Another example involves Label This, a group that determines “which products include genetically engineered ingredients and then prints up labels which members independently attach to products in grocery stores before they are sold.”⁴² The group hired an artist to alter the packaging of products with his own artistic work to subvert the commercial space.⁴³ Katyal even uses the Yes Men’s stunt against the Dow Chemical Corporation as an example.⁴⁴ The Yes Man stunt against the Chamber thus demonstrates how continuous this strain of semiotic disobedience is in the present time; it is still widespread for iconoclasts to mock the captains of government and industry, even though it comes with legal consequences. The Chamber is the “king” of big business, representing an elite clientele. They are thus the easy target for the perennial semiotic deviant.

Trademark law has generally favored the target of semiotic deviance. William E. Ridgway explains a distinction between patent, copyright, and trademark law. As Ridgway explains, “Patents and copyrights remedy a public goods problem by providing limited

38. *Id.* at 494.

39. *Id.* at 504.

40. *Id.*

41. *Id.*

42. *Id.* at 505–06.

43. *Id.* at 506.

44. *Id.* at 505.

exclusivities in return for the creation of new ideas and expression.”⁴⁵ In essence, patents and copyrights strike a balance between the incentive to create and the resulting societal costs. However, trademarks “impose exclusionary rights that narrow the public domain.”⁴⁶ In other words, the big distinction is consumer confusion. This key element to trademarks shifts the balance and makes the property holders’ interests less worthy of protection than the consumers’ interests.⁴⁷ Thus while copyrights and patents generally hurt the consumer, trademarks allow consumers to rely on their knowledge of the quality of the product, which promotes social interest.⁴⁸

Of course, trademark protection does not always outweigh First Amendment concerns. Fair use is still a legitimate defense to consumer confusion, and consumer confusion is not easy to prove.⁴⁹ Case law shows that one of the noticeable qualities that plaintiffs seem to share is that they are often private, profit-based organizations. In *Mattel v. MCA Records*, the court stated that “in general the [Lanham] Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.”⁵⁰ In that case, the Mattel Corporation sued numerous record companies for the use of the Barbie trademark in the Aqua song, “Barbie Girl.”⁵¹ The court ruled that “the song title does not explicitly mislead as to the source of the work; it does not, explicitly or otherwise, suggest that it was produced by Mattel.”⁵² Essentially, the court determined that consumers would not mistake Aqua’s song with the Barbie doll.

In another 9th Circuit decision, the court analyzed parody as an element of confusion.⁵³ Courts have utilized both a six and eight-factored test to analyze confusion. The court in *AMF Inc. v. Sleekcraft Boats* created the eight-factor test as follows:

45. William E. Ridgway, *Revitalizing the Doctrine of Trademark Misuse*, 21 BERKELEY TECH. L.J. 1547, 1558 (2006).

46. *Id.*

47. *Id.*

48. *Id.*

49. 15 U.S.C. § 1114 (1946).

50. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 903 (9th Cir. 2002) (citing *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989)).

51. *Id.* at 899.

52. *Id.* at 902.

53. *Dr. Seuss Enter., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1403 (1997).

(1) strength of the mark; (2) proximity of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) type of goods and the degree of care likely to be exercised by the purchaser; (7) defendant's intent in selecting the mark; (8) likelihood of expansion of the product line.⁵⁴

In *Dr. Seuss Enterprises*, the question was whether the classic Dr. Seuss children's book, *The Cat in the Hat*, had been confused with *The Cat NOT in the Hat!*, a parody about the OJ Simpson trial.⁵⁵ Interestingly, the court does not go into much depth as to what the elements of parody are. Rather, the court states that there are "confusing parodies and non-confusing parodies," the distinction being that "[t]rue parody will be so obvious that a clear distinction is preserved between the source of the target and the source of the parody."⁵⁶

This holding at once poses two issues. The first issue is an ironic one: Can a parody be too good? It seems intuitive that something created for mocking, humorous value, or "merely amusing," as the Ninth Circuit in *Dr. Seuss Enterprises* flippantly calls it, will resemble its target. One need only turn on the television to see parody, but there seems to be an assumption by the *Dr. Seuss Enterprises* court that the parody will never quite be precise in nature. Yet parody adds to the confusion and, therefore, to the possible liability when the parody depicts the target accurately. One may think of the Rob Reiner film, *This Is Spinal Tap*, the first of the now popular line of "mockumentaries," and how much more poor a film it would have been if it had not been so realistic.⁵⁷ This film certainly confused many people and may have seemed to be a true documentary of a real band to the untrained eye.⁵⁸ Perhaps the movie avoided liability only because the mark that was "stolen" was not a mark at all, but rather the *idea/expression* of the 1970s and 1980s heavy metal scene, and not a particular band.

The ironic position of holding an accurate parody more likely to be liable, in general, must necessarily remain untenable in a semiotic

54. AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 348-49 (9th Cir. 1979).

55. *Dr. Seuss Enter.*, 109 F.3d at 1403.

56. *Id.* at 1405.

57. Roger Ebert, *This is Spinal Tap*, ROGEREBERT.COM (Mar. 1, 1985), <http://roger-ebert.suntimes.com/apps/pbcs.dll/article?AID=/19850301/REVIEWS/503010301/1023>.

58. *Id.*

democracy. Katyal cites a piece in the *New York University Law Review* by Jack Balkin who states:

Freedom of speech is appropriative because it draws on existing cultural resources; it builds on cultural material that lay to hand. Dissenters draw on what they dislike in order to criticize it; artists borrow from previous examples and build on artistic conventions; even casual conversation draws on common topics and expressions In a democratic culture people are free to appropriate elements of culture that lay to hand, criticize them, build upon them, and create something new that is added to the mix of culture and its resources.⁵⁹

Although one may be hesitant to describe semiotic disobedience as a new sort of liberation movement, such as the Civil Rights Movement of the 1960s, certainly there is nothing more American or constitutional than affirming the right to free expression and increasing liberty. As Katyal states:

By reoccupying the symbol, and then reinscribing it with a new meaning, semiotic disobedience creates a modality that shifts the character of the speech in two major ways: first, the identity of the speaker shifts from a corporation to a potential consumer; and second, the identity of the brand shifts from a commercial commodity into an expression of political significance.⁶⁰

Thus, the idea that a parody can be too perfect or too realistic flies in the face of a basic right to free expression. The numinous quality of a particularly poignant parody is just as much a part of the beauties and guarantees of the First Amendment as the right to peacefully protest. In fact, parody may be the most salient form of peaceful and more importantly, ironic, protest.

However, one must accord a certain respect to the argument that too realistic a parody can easily hurt a corporation or some other entity. The case at hand with the Yes Men and the Chamber provides a great example of a parody that was too good and which could have had dire consequences. It is easy to imagine a situation where news from a fake press conference could severely affect the economy. Therefore, the balance of interests seems to favor advocacy and

59. Katyal, *supra* note 35, at 510.

60. *Id.* at 512.

lobbyist groups, and the government. However, the constitutional issue is not one sided. As Ridgway states:

Origin may militate in favor of an equitable misuse doctrine that emphasizes First Amendment values. Within First Amendment jurisprudence, one mode of argument, which Eugene Volokh calls the “constitutional tension method,” identifies certain values that the Constitution explicitly protects and then suggests that the Constitution’s free speech guarantee must sometimes yield to these values. Of course, this method is not determinative; the Constitution contains several “values,” such as democracy, private property, and equality, to which the First Amendment cannot automatically defer without eviscerating free speech. Rather, the constitutional origins of patent and copyright law simply weigh in favor of less exacting First Amendment scrutiny.⁶¹

Ridgway correctly argues that trademark protection is special because it is an intellectual property device that, when imposed, gives the public more clarity regarding their purchases and use. As the case law demonstrates, if courts deem consumer confusion to be problematic, they will regularly uphold a trademark infringement claim, including ones brought by constituent-based groups. One court dismissed a case where the People for the Ethical Treatment of Animals (“PETA”) sued the defendant, Michael Doughney, for appropriating the use of the internet domain name “PETA.ORG.”⁶² In this case, Doughney created a site claiming that “PETA” or “People Eating Tasty Animals” stood for the eating of meat and the wearing of fur, two of several claims on Doughney’s site which are diametrically opposed to the *real* PETA’s values. The court had no problem affirming the lower court’s granting of summary judgment in favor of PETA and ordered Doughney to release the domain name to PETA.⁶³

In the present case between the Chamber and the Yes Men, the Chamber should prevail because it is an advocacy group. The distinction may seem superficial, but the argument arises from the practical effects of the confusion, which the court may deem a factor of the confusion element of the Lanham Act protection. The

61. Ridgway, *supra* note 45, at 1561–62.

62. People for the Ethical Treatment of Animals, Inc. v. Doughney, 263 F.3d 359 (4th Cir. 2001).

63. *Id.* at 371.

Chamber, along with all lobbyist groups and government entities, represent too many people and sub-entities to risk consumer confusion. In the *Mattel* case, consumer confusion, even if it was found, would not lead to dire economic consequences. Sure the balance of the market of dolls may have shifted, but causing confusion about an advocacy group could lead to lost constituents, withdrawal of investments, and so forth. The next section will discuss commercial intent, another element of the Lanham Act protection.

IV. Commercial Intent

In 1996, Congress expanded the ambit of Lanham Act protection by enacting the Federal Trademark Dilution Act (“FTDA”), “which prohibits the ‘commercial use in commerce’ of a ‘famous’ mark, if that use causes ‘the lessening of the capacity’ of the mark ‘to distinguish goods or services.’”⁶⁴ Currently, the statute reads, “[t]he registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive.”⁶⁵ Thus, not only must a parody confuse the public, but it also must have some sort of commercial intent.

Case law has generally held that parody, especially when constituting “humor” and “visual and verbal editorial comment,” enjoys a full First Amendment protection.⁶⁶ In *Hoffman v. Capital Cities/ABC, Inc.*, a magazine digitally altered images of actors from famous films, such as Dustin Hoffman from the film, *Tootsie*.⁶⁷ Hoffman sued under the Lanham Act after his cross-dressing character from *Tootsie* was altered to appear wearing contemporary spring fashions.⁶⁸ The Ninth Circuit held that the commercial purpose of the advertisements was “inextricably entwined with [these] expressive elements” and therefore deserved full First Amendment protection.⁶⁹ Similarly in *Mattel*, the Ninth Circuit held that “Barbie Girl is not purely commercial speech, and is therefore fully protected [under the First Amendment].”⁷⁰ Referencing *Hoffman*, the court in *Mattel* reasoned that the humor and lampooning character of the song

64. Ridgway, *supra* note 45, at 1564.

65. 15 U.S.C. § 1114 (1946).

66. *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1189 (9th Cir. 2001).

67. *Id.* at 1183.

68. *Id.*

69. *Id.* at 1185.

70. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 906–907 (9th Cir. 2002).

falls squarely within the “noncommercial use exemption” of the FTDA.⁷¹

While it is true that the FTDA has a noncommercial use exemption,⁷² the court in *Mattel* seems to extend a carte blanche to all types of parody groups. The *Mattel* court argues that, in and of itself, humor and by extension, parody, constitutes a purpose outside of commercial use.⁷³ The basis for this understanding of the FTDA is theoretically sound. The *Mattel* court quotes the legislative history behind the FTDA, stating that “‘Noncommercial use’ refers to a use that consists entirely of noncommercial, or fully constitutionally protected, speech.”⁷⁴ The court states the exemption includes parodies.⁷⁵

This sweeping exemption should not always hold muster, contrary to the *Mattel* court’s understanding. The Chamber, for instance, makes the point that the Yes Men, through their prank, publicized themselves right before the release of their then upcoming film.⁷⁶ Distinct from the doctored picture of Hoffman or the song, “Barbie Girl,” the entirety of the Yes Men’s career is completely dependent on parody. Commercial benefit is not incidental to the parody as it is in the case of *Mattel*. Rather, commercial benefit is directly related to the parody. To hold otherwise would devalue the commercial intent element of the Lanham Act. If courts deem commercial intent incidental to alternate purposes of selling a product, how could any entity be held accountable for theft of a trademark? It could be argued that any theft of trademark falls under the protected speech of freedom of expression. A company sporting a knock-off could, in other words, claim that the knock-off is exempt from liability under the Lanham Act due to a First Amendment protection.

Rather, the *Mattel* court’s reliance on legislative intent is misplaced. The court states, “Upon introducing the counterpart bills, sponsors in each house explained that the proposed law ‘will not prohibit or threaten noncommercial expression, such as parody, satire, editorial and other forms of expression that are not part of a commercial transaction.’”⁷⁷ Thus, the Congressional records explicitly

71. *Id.*

72. 15 U.S.C. § 1125 (1946).

73. *Mattel*, 296 F.3d at 906.

74. *Id.* at 905.

75. *Id.*

76. Complaint and Demand for Jury Trial at 7, Chamber of Commerce of the US v. Servin, 1:09-cv-02014-RWR (filed Oct. 26, 2009).

77. *Mattel*, 296 F.3d at 905.

mention parody as something that would fall under noncommercial expression. This type of appeal to legislative history shows the fallacy in using such evidence for an understanding of how the law should *always* be interpreted. Justice Antonin Scalia stated that where a statute's plain meaning "produces an absurd, and perhaps unconstitutional, result, [it is] entirely appropriate to consult all public materials, including the background of [the statute] and the legislative history of its adoption."⁷⁸ Here, in the case of the Chamber and the Yes Men, strict adherence to plain meaning would produce an absurd result. The problem with analyzing a statute utilizing legislative intent is that Congress can never anticipate every outcome that would lead to a noncommercial exemption. The Congressional record, while listing parody, nowhere delineates what is meant by parody. In the case of the Yes Men, parody is the entirety of their work.⁷⁹ Rather than utilizing legislative intent, courts should adopt an *ad hoc* approach to decisions of this nature, where the legislative intent may control in conventional cases but which must be discarded in cases such as this. The absurdity in the result of such an exemption for the Yes Men would allow them to parody anyone and anything, no matter how confusing the mimicry.

Many courts, like the Ninth Circuit in *Mattel*, and scholars laud the drive towards freedom of speech in the balance of First Amendment and trademark interests. Some scholars such as Ridgway have noticed courts making distinctions between protected and unprotected speech in terms of trademark, where a majority of courts "categorize trademark use as unprotected 'commercial' speech on the basis of any commercial intent or impact on a trademark holder's own commercial interests."⁸⁰ Ridgway cites the case, *Planned Parenthood Federation of America, Inc. v. Bucci*⁸¹ as evidence of the way courts generally handle such trademark versus First Amendment cases. In that case, Bucci, a pro-life activist, took the domain name *plannedparenthood.com*.⁸² Planned Parenthood then attempted to enjoin Bucci from operating such a site.⁸³ As the court

78. *Id.* (citing *Green v. Bock Laundry Mach. Co.*, 490 U.S. 504, 527(Scalia, J., concurring)).

79. THE YES MEN FIX THE WORLD, <http://theyesmenfixtheworld.com>, (last visited Aug. 25 2010).

80. Ridgway, *supra* note 45, at 1574.

81. *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, 42 U.S.P.Q. 2d (BNA) 1430 (S.D.N.Y. 1997).

82. *Id.* at 1432.

83. *Id.*

stated, “The question the Court must decide, then, is whether defendant’s use of plaintiff’s mark is properly viewed as in connection with the distribution or advertising of goods or services.”⁸⁴ The court held, “[D]efendant’s use of plaintiff’s mark is ‘commercial’ for three reasons: (1) defendant is engaged in the promotion of a book, (2) defendant is, in essence, a non-profit political activist who solicits funds for his activities, and (3) defendant’s actions are designed to, and do, harm plaintiff commercially.”⁸⁵

Essentially, the court held that the “[s]ite harmed Planned Parenthood commercially and that Bucci solicited funds on his radio show while mentioning the website.”⁸⁶ Thus, the court employed a standard that limited First Amendment protection to avoid the absurd result that “‘commercial’ speech would include all speech that is sold, including books, newspapers, and magazines, and the government could ban any speakers with economic intent, such as workers who rally for higher pay.”⁸⁷

Ridgway makes the point that the noncommercial use exemption favors “critical and parodic treatments over other uses of protected material.”⁸⁸ Ridgway goes on to say that parody and humor very often advance “trademark law’s central purpose of reducing consumer search costs.”⁸⁹ Although Ridgway correctly identifies the state of affairs in the trademark versus First Amendment balance, he fails to point out the inconsistencies in the current doctrine. In the next section, the current doctrine will be critiqued for applying ad hoc, discretionary, and exceptional standards in one regard, while professing a deep-seated devotion to First Amendment protection on the other. Such a doctrine leads to a vague standard which does not adequately distinguish various types of consumer confusion and commercial intent.

V. Proposal

The fact that scholars and courts overlook distinctions within parody groups is the primary fallacy in this area of jurisprudence. Courts have done a poor job in defining parody. The court in *Dr. Seuss Enterprises* uses the dictionary to define parody as “a ‘literary

84. *Id.* at 1435.

85. *Id.* at 16.

86. Ridgway, *supra* note 45, at 1573.

87. *Id.* at 1573–74.

88. *Id.* at 1582.

89. *Id.* at 1583.

or artistic work that broadly mimics an author's characteristic style and holds it up to ridicule."⁹⁰ The *Mattel* court, rather than define parody, accepts the legislative understanding of parody as part of protected expression in the milieu of satire, editorial, and other forms of expression.⁹¹

The court in *People for the Ethical Treatment of Animals* defines parody, but in so doing ironically obfuscates the discussion and almost certainly would have been better off leaving the term vague as is.⁹² The court defines parody as a "simple form of entertainment conveyed by juxtaposing the irreverent representation of the trademark with the idealized image created by the mark's owner."⁹³ The court attempts to elucidate this definition further, stating that a parody must "convey two simultaneous—and contradictory—messages: that it is the original, but also that it is not the original and is instead a parody."⁹⁴ Ultimately the court turns the discussion of parody into a matter of balancing the rights of the social critic to create a simulacrum faithful to the original work and the risk of consumer confusion.⁹⁵ An, "effective parody," the court states, "will diminish the risk of consumer confusion 'by conveying [only] just enough of the original design to allow the consumer to appreciate the point of parody.'"⁹⁶

Thus, while the court does on its face further a definition of parody, the problem of definition is not solved. Rather, the court uses terms such as "effective" in a subjective manner as to a legitimate parody may be. This type of language only creates more confusion and equivocation as to what an effective parody, let alone *just* a parody, actually is. Additionally, instead of essentially choosing a side in the debate, favoring either the interest of preserving social criticism in the form of mockery or the interest of preserving consumer rights, the court echoes the balancing act. Such a reiteration of the question does not advance the analysis of defining

90. *Dr. Seuss Enter., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1401 (1997).

91. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 905 (9th Cir. 2002).

92. *People for the Ethical Treatment of Animals*, 263 F.3d at 359.

93. *Id.* at 366 (quoting *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 34 (1st Cir. 1987)).

94. *Id.* (quoting *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ. Group, Inc.*, 886 F.2d 490, 494 (2d Cir. 1989)).

95. *Id.*

96. *Id.* (quoting *Jordache Enterprises, Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1486 (10th Cir. 1987)).

parody but rather repeats the obvious. Thus, the court fails to adequately define parody.

Parody, while mentioned, is not defined in the Lanham Act.⁹⁷ There are three basic defenses to trademark infringement. The most notable one in this case, “fair use,” which includes “parodying,” has already been discussed.⁹⁸ The other two defenses are “all forms of news reporting and news commentary” and “any noncommercial use of a mark.”⁹⁹ Even if the *Mattel* court correctly assessed the legislative intent to exempt parody from trademark infringement, there is no delineation of what constitutes parody.¹⁰⁰

In the case of the Yes Men and the Chamber, there are many distinctions that could be made between the work of the Yes Men and for instance, the song, “Barbie Girl.” As the court states, the song by Aqua “[d]oes not explicitly mislead to the source of the work; it does not, explicitly or otherwise, suggest that it was produced by Mattel.”¹⁰¹ Rather, the song title and the lyrics of the song itself reflect the values and superficialities that the Mattel Barbie doll represents.¹⁰²

However, in the case of the Yes Men, the public is dealing with a group that focuses *solely* on parody. The Yes Men claim that “[t]he stunt was intended to show how climate policy was being held hostage to corporate greed.”¹⁰³ However, the Yes Men’s commercial exploits involve parody films. The Yes Men describe their activities in their most recent filming as “posing [as the] top executives of corporations they hate.”¹⁰⁴ The entirety of the movie revolves around the Yes Men parodying and posing as representatives of corporations. For example, “[a]s Exxon, Andy and Mike demonstrate a new biofuel made from climate-change victims.”¹⁰⁵ Perhaps because the Yes Men achieve commercial success primarily because of their work in parody, the Yes Men have decided to pull their recent film from DVD distribution as evidence that they are not liable for trademark

97. 15 U.S.C. § 1125 (1946).

98. *Id.*

99. *Id.*

100. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 905 (9th Cir. 2002).

101. *Id.* at 902.

102. *Id.*

103. Suzanne Goldenberg, *US Chamber of Commerce falls victim to ‘fraud’ over climate hoax*, THE GUARDIAN ENV’T BLOG (Oct. 19, 2009, 6:50 PM), <http://www.guardian.co.uk/environment/blog/2009/oct/19/chamber-commerce-climate-hoax>.

104. *Story*, THE YES MEN FIX THE WORLD, <http://theyesmenfixtheworld.com/story.htm> (last visited Sept. 29, 2010).

105. *Id.*

infringement.¹⁰⁶ Rather, the film has been released for free on BitTorrent, requiring no payment for viewing and asking for donations instead.¹⁰⁷ There are a number of other reasons besides avoiding presumed commercial intent for why the Yes Men released their film for free. For one, none of the major networks will promote or distribute the film until the lawsuit is resolved.¹⁰⁸ Additionally,

They also did it to avoid paying for E&O or ‘errors and omissions’ insurance, which documentary filmmakers are often required to buy if they can’t verify that every detail in the fore or background of every shot is free of copyright infringement. The E&O requirement is a huge hurdle for independent filmmakers.¹⁰⁹

Nonetheless, the fact that commercial distributors will not promote the film and the proximity of the decision to make the film available for free during the lawsuit shows how much the Yes Men’s parody is directly linked to commercial intent.

Thus, unlike to the Aqua song, there is not much else to the Yes Men aside from parody. “Barbie Girl” is a song that relies on music, videos, lyrics, production, and electronics, none of which solely rely on any Mattel product.¹¹⁰ Whether one believes the Yes Men parody of the Chamber was confusing, it is clear that the type of parody in which the Yes Men engage is very different from the type of parody that Aqua engaged in with their song. The disparity in just these two examples demonstrates the necessity of a judicial definition of parody.

This lack of judicial definition seems to stem in part from the general catchall exemption from trademark infringement that comes from the First Amendment. Case law, scholarship, and certainly United States legal history suggest the importance of the doctrine of freedom of speech in our “American semiotic democracy.” The *Mattel* case is, for instance, replete with references to the First Amendment and the public policy behind freedom of expression in the form of parody. As the court states, “[T]ension with the First

106. Samuel Axon, *The Yes Men Movie Dodges Legal Challenge by Launching on BitTorrent*, MASHABLE (July 26, 2010) <http://mashable.com/2010/07/26/the-yes-men-bittorrent>.

107. *Id.*

108. *Id.*

109. *Id.*

110. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 901 (9th Cir. 2002).

Amendment also exists in the trademark context, especially where the mark has assumed an expressive function beyond mere identification of a product or service.”¹¹¹

Katyal claims that the First Amendment “already favors semiotic democracy over disobedience where national symbols are concerned.”¹¹² She even brings up an early case where the abolitionist William Lloyd Garrison, in 1854, “burned his copy of the Constitution to protest its original bias toward slavery.”¹¹³ Such an act, states Katyal, “add[s] a classically new focus to the old regime of civil disobedience, because it forces the democratic and judicial processes to grapple with the alteration of properties that fall outside traditional realms of protected speech and intellectual property.”¹¹⁴

In terms of the original intent of the First Amendment, there is a rich history of the conflicts and debates regarding the federal government’s power in legislating speech. The proponents of a smaller federal government, such as Thomas Jefferson and Andrew Hamilton, had been embroiled in free speech issues since long before the revolution.¹¹⁵ For instance, in 1735, Hamilton defended John Peter Zenger, who was tried for “seditious libel.”¹¹⁶ Hamilton’s victorious defense became widely known and is one of the forbearers of the right to free speech in the United States.¹¹⁷

As important as free speech has been to this country, there have been numerous exceptions to this protection. The most famous utterance of the exception to the seemingly catchall protection from governmental intrusion into free speech comes from *Schenck v. US* where Justice Oliver Wendell Holmes, in referring to an obvious exception to First Amendment protection, coined the term “shouting fire in a crowded theater.”¹¹⁸ Although the Supreme Court has tended to allow more dissident, obscene, and politically hazardous speech,¹¹⁹ the fact that unfettered free speech is still clearly an issue suggests that absolute freedom of speech is not a right where there

111. *Id.* at 904.

112. Katyal, *supra* note 35, at 562.

113. *Id.*

114. *Id.*

115. Doug Linder, *The Trial of Peter Zenger: Birth of freedom of the press*, AMERICA.GOV (Apr. 3, 2008), <http://www.america.gov/st/educ-english/2008/April/20080422131918eaifas0.6481439.html>.

116. *Id.*

117. *Id.*

118. *Schenck v. U.S.*, 249 U.S. 47, 52 (1919).

119. *See New York Times Co. v. US*, 403 US 713 (1971) (allowing the *New York Times* and *Washington Post* to publish the then classified Pentagon Papers).

are harmful consequences. In an article on the effects of users utilizing trademarks on social networking sites, Professor Lisa Ramsey suggests,

Impersonation of brands on social network sites may cause a variety of harms if users believe and rely on the imposter's false statement of identity. If users disclose personal information to the imposter, identity theft, phishing, or an increase in spam emails may occur. Even if the user suffers no financial harm, he or she may feel violated . . . If goods or services promoted on the page are falsely represented to come from the markholder, customers may mistakenly purchase another company's products, which may be of lower quality. If the imposter posts false or misleading information about the company or its products, this can harm the markholder and the public if stock prices drop, or if individuals or entities forgo future purchases, employment, partnerships, or other interaction with the company due to the untruthful information.¹²⁰

Ramsey therefore recognizes that users of trademarks on social networking sites may cause obvious and ruinous harm, similar to a parody group irreparably besmirching the name of its victim.

Thus, in the case of trademark infringement, *ad hoc*, courts can take practical determinations into consideration and still uphold the basic tenets of First Amendment rights. In the case of the Chamber, potential consumer confusion can seriously damage political and economic ties. The Chamber is ranked as one of the top five best-known and respected organizations in Washington.¹²¹ It represents an enormous amount of wealth and if disaster should strike which induces businesses to leave the Chamber, the entire lobbying industry would change overnight. This suggests that there should be more trademark protection for advocacy groups and governmental institutions, as a single trademark infringement included in a parody could, as in this case with the Yes Men, cause temporary panic. Freedom of speech is a very important right and in a case such as *Mattel*, where the stakes are somewhat lower, the right to free speech trumps trademark protection. However, because the courts do have

120. Lisa P. Ramsey, *Brandjacking on Social Networks: Trademark Infringement by Impersonation of Markholders*, 58 BUFF. L. REV. (forthcoming 2010) (manuscript at 15).

121. *About Us*, U.S. CHAMBER OF COMMERCE <http://www.uschamber.com/about/> (last visited Aug. 25, 2010).

the authority to limit freedom of speech when practically necessary, advocacy groups such as the Chamber deserve an extra level of protection.

VI. Conclusion

Although the Yes Men may have had a legitimate anti-corporate message and may have pulled off their stunt very well, their actions could have caused a panic. The U.S. Chamber of Commerce and other advocacy groups, are vastly important to the political and economic realities of the average American household. Their lobbying helps influence the level of taxes, defense spending, or as in this case, environmental policy reform. First Amendment protection should generally be a presumed right in the case of most trademark cases. However, in cases where the stakes are high, the risk of consumer confusion is too great to allow an unfettered right to parody.